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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,510	06/29/2001	Brian Rasmussen	SUN-P6236	8236

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EXAMINER
LABAZE, EDWYN

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 12/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/895,510	Applicant(s) RASMUSSEN ET AL.	
	Examiner EDWYN LABAZE	Art Unit 2876	

-- Th MAILING DATE of this communication appears on th cov r sh t with th correspond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 June 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

1. Claim 2 is objected to because of the following informalities:

Re claim 2 (page 11, line 11): The word "ID" should be spelled out with "identification".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-5, and 9-13 is rejected under 35 U.S.C. 102(e) as being unpatented by Khan et al. (U.S. 6,401,206).

Re claim 1: Khan et al. discloses a method and apparatus for binding electronic impressions made by digital identities to document, which includes methods of issuing or providing a smart card or a digital identity to a user (col.3, lines 66+, and col.4, lines 36-40);

issuing manual authentication information to the user (col.4, lines 19-30); authenticating the user and the smart card using the manual authentication information 402 (col.5, lines 59-66); obtaining a public key from the smart card 102 (col.5, lines 37-57); and issuing a digital certificate using the public key to the smart card to activate the smart card 4008 (col.7, lines 1-4).

Re claim 2 and 10: Khan et al. teaches a method, wherein the manual authentication information comprises a user ID and a password 4003, 4004 (col.6, lines 37+).

Re claims 3 and 11: Khan et al. discloses a method, which further comprises obtaining the digital certificate from a certificate authority 4009 (col.7, lines 1-4).

Re claims 4 and 12: Khan et al. teaches a method, wherein the authenticating further comprises connecting the smart card to a workstation or terminal computer 4301 (col.8, lines 65+).

Re claims 5 and 13: Khan et al. discloses a method, which comprises storing the digital certificate in at least one of the smart card and the workstation 3 (col.11, lines 5-14).

Re claim 9: Khan et al. teaches a method, comprising of receiving a smart card 703 (col.6, lines 14-36); receiving manual authentication information 106 (col.5, lines 53+); authenticating the smart card using the manual authentication information 4306 (col.9, lines 31-46); generating a public key using the smart card 4008 (col.7, lines 9+); sending the public key to an administration server (col.10, lines 46-67 and col.11, lines 1-4); and receiving a digital certificate generated using the public key to activate the smart card (col.11, lines 5+).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 6, 14, and 17-19, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan et al. (U.S. 6,401,206) in view of Boroditsky et al. (U.S. 6,332,192).

The teachings of Khan et al. have been discussed above.

Khan et al. fails to show a method of initiating a login request to a server and if authenticated, permitting a login to a computer resource.

Boroditsky et al. teaches a generalized user identification and authentication system, which includes a Prover or verifier 1 system comprising methods of initiating a request and if authenticated, permitting access to a computer resource (col.3, lines 30+; and col.5, lines 8-62).

In view of Boroditsky et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the Prover system into the teaching of Khan et al. due to the fact that the Prover system that includes a computer network featuring ID and password requirements that which is designed to verify/authenticate the smart card and is beneficial in preventing tampering or forgery of digital identity/smart card/encoded documents. In addition, the Prover system also serves as link/access to a computer resource or database as the authentication of the smart card is verified. Moreover, such modification would have been an obvious extension as taught by Khan et al., therefore an obvious expedient.

Re claim 18: Khan et al. discloses a method, wherein the digital certificate is obtained by obtained a public key from the smart card, and receiving the digital from a certificate authority (col.7, lines 1-4)

Re claim 19: Khan et al. discloses a method, which further comprises obtaining the digital certificate from a certificate authority 4009 (col.7, lines 1-4).

Re claim 21: Khan et al. teaches a method, which comprises storing the digital certificate in at least one of the smart card and the workstation 3 (col.11, lines 5-14).

6. Claims 7,15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan et al. (U.S. 6,401,206) in view of Boroditsky et al. (U.S. 6,332,192).

The teachings of Khan et al. have been discussed above.

Khan et al. fails to show a method of removing the smart card after login is authenticated.

Boroditsky et al. discloses a method, wherein the authenticating further connecting the smart card to a workstation or computer, removing the smart card from the workstation after the authenticating (col.13, lines 1-32).

In view of Boroditsky et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teaching of Khan et al. a system allowing the user to remove the digital identity or smart card from the workstation after the authenticating. Furthermore, the verifier system would be very beneficial to the user and would prevent thief or access to stolen property by leaving or forgetting the digital identity/smart card into the terminal, which can be redeemed by anyone and would assure the security of personal information being in the wrong hands. Moreover, such modification would have been an obvious extension of the teaching of Khan et al.

7. Claims 8,16, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan et al. (U.S. 6,401,206) in view of Boroditsky et al. (U.S. 6,332,192).

The teachings of Khan et al. have been discussed above.

Khan et al. fails to show a method of determining that the digital certificate or smart card has not been revoked or disallowed.

Boroditsky et al. teaches a method, wherein the authenticating further comprises determining that the digital certificate has not been revoked or disallowed (col.11, lines 51+).

In view of Boroditsky et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to include a method of determining that the digital certificate has been revoked or disallowed into the teaching of Khan et al. in order to keep the user informed of the validity of the certificate. In addition, and as stated previously the verifier system is designed to allow the user to login or have access to the computer resource by verifying/authenticating the smart card/digital identity, permit the user to remove the card or digital identity after authenticating and also to determine if the digital certificate is valid or not been revoked of as a result of the authenticity of the smart card or digital identity. Furthermore, such modification would have been an obvious extension of the teaching of Khan et al., and therefore an expedient.

8. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan et al. (U.S. 6,401,206) in view of Boroditsky et al. (U.S. 6,327,659) and of Yacobi (U.S. 5,872,844).

Re claim 23, and 25: Khan et al. discloses a method and apparatus for binding electronic impressions made by digital identities to document, which includes methods of issuing or providing a smart card or a digital identity to a user (col.3, lines 66+, and col.4, lines 36-40); issuing manual authentication information to the user (col.4, lines 19-30); authenticating the user and the smart card using the manual authentication information 402 (col.5, lines 59+); obtaining a public key from the smart card 102 (col.5, lines 37-57); and issuing a digital certificate using

the public key to the smart card to activate the smart card 4008 (col.7, lines 1-4), and storing the digital certificate in at least one of the smart card and the workstation 3 (col.11, lines 5-14).

Khan et al. fails to teach a method of sending and initiating a login request to a server and if authenticated, permitting a login to a computer resource.

Boroditsky et al. teaches a generalized user identification and authentication system, which includes a Prover or verifier 1 system comprising methods of initiating a request and if authenticated, permitting access to a computer resource (col.3, lines 30+; and col.5, lines 8-62).

In view of Boroditsky et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the Prover system into the teaching of Khan et al. due to the fact that the Prover system that includes a computer network featuring ID and password requirements that which is designed to verify/authenticate the smart card and is beneficial in preventing tampering or forgery of digital identity/smart card/encoded documents. In addition, the Prover system also serves as link/access to a computer resource or database as the authentication of the smart card is verified. Moreover, such modification would have been an obvious extension as taught by Khan et al., therefore an obvious expedient

Khan et al. as modified by Boroditsky et al. fails to teach a method of authenticating the digital certificate against a certificate revocation list to determine that the digital certificate has not been revoked.

Yacobi discloses a system and method and system for detecting fraudulent expenditure of transferable assets, which includes authenticating an electronic wallet against a certificate revocation list to determine that the electronic wallet has not been revoked (col.9, lines 24-61).

In view of Yacobi's teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate a database comprising of a certificate revocation list into the teachings of Khan et al. as modified by Boroditsky et al. Furthermore, the certificate revocation list would generate a comparison database and evaluate all new request of digital identity/smart card/ electronic wallet with all previously recorded bad or negative files in order to establish complete authenticity. Moreover, such modification would be beneficial in preventing fraud, be selective in responding to new request for digital identity/smart card or electronic wallet, and therefore would have been an obvious extension as of the teaching of Khan et al. as modified by Boroditsky et al.

Re claim 24: Khan et al. fails to teach a method of removing the smart card or digital identity from the workstation after authenticity.

Boroditsky et al. discloses a method, wherein the authenticating further connecting the smart card to a workstation or computer, removing the smart card from the workstation after the authenticating (col.13, lines 1-32).

In view of Boroditsky et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teaching of Khan et al. a system allowing the user to remove the digital identity or smart card from the workstation after the authenticating. Furthermore, the verifier system would be very beneficial to the user and would prevent thief or access to stolen property by leaving or forgetting the digital identity/smart card into the terminal, which can be redeemed by anyone and would assure the security of personal information being in the wrong hands. Moreover, such modification would have been an obvious extension of the teaching of Khan et al.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Claus et al. (U.S. 5,120,939) discloses a databaseless security system.

Boroditsky et al. (U.S. 6,327,659) teaches a generalized user identification and authentication system.

Sudia (U.S. 5,799,086) discloses an enhanced cryptographic system and method with escrow feature.

Teicher et al. (U.S. 6,257,486) teaches a smart card PIN system, card, and reader.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (703) 305-5437. The examiner can normally be reached on 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

el
Edwyn Labaze
Patent Examiner
Art Unit 2876
December 13, 2002

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